

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: AMIT D. AGARWAL
APPLICATION NO.: 09/558,313
FILED: APRIL 25, 2000
FOR: AUTOMATICALLY INITIATING
PRODUCT REPLENISHMENT

EXAMINER: CHRISTOPHER R.
BUCHANAN
ART UNIT: 3627
CONF. NO: 9641

Reply Brief Under 37 C.F.R. § 41.41

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief responds to the Examiner's Answer mailed on October 12, 2007 in the above-identified application, and is in furtherance of the Notice of Appeal filed on March 6, 2006, and the Appeal Brief filed on August 1, 2006.

I. STATUS OF CLAIMS

Claims 1-47 have been presented; claim 38¹ has been canceled; claims 1-37 and 39-47 are presently pending and stand finally rejected.

The Examiner rejected claims 1-26, 36-38, and 41-43 under 35 U.S.C. § 103(a) over a combination of U.S. Patent No. 6,026,376 to Kenney ("Kenney") and U.S. Patent No. 5,909,023 to Ono et al. ("Ono").

The Examiner rejected claims 27-35 and 45-47 under 35 U.S.C. § 103(a) over a combination of Kenney, Ono, and U.S. Patent No. 5,655,174 to Hirst ("Hirst").

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Is the rejection of claims 1-26, 36-37, and 41-43 under 35 U.S.C. § 103(a) over a combination of Kenney and Ono proper?

Is the rejection of claims 27-35 and 45-47 under 35 U.S.C. § 103(a) over a combination of Kenney, Ono, and Hirst proper?

III. ARGUMENTS IN REPLY TO EXAMINER'S ANSWER

- A. Kenny Does Not Teach or Suggest Providing a Consumer with an Indication that a Product Should Be Replenished, the Indication Including a Control Usable by the Consumer to Request Replenishment of the Product

On page 4 of the Examiner's Answer, the Examiner states:

The user is provided with an indication that the product should be replenished (see Figs 5 and 7, col. 12 line 50+, it is displayed which products need to be reordered). The consumer then requests replenishment of the product by performing an interaction (clicking on the displayed product, col. 12 line 56) and the product is ordered (see Fig. 10A).

Applicants respectfully disagree. Contrary to the Examiner's position, Kenny does not teach or suggest providing an indication that a product should be replenished, the indication including a control usable by the consumer to request replenishment of

¹ On December 10, 2007, Appellants filed an amendment pursuant to 37 C.F.R. § 41.37 canceling claim 38. The cancellation of this claim does not affect the scope of any other pending claim in this proceeding.

the product. The Examiner appears to suggest that either Kenny's reorder list 30 (Figure 7) or Kenny's distinctive display of items on a shopper's reorder list (Figure 5) corresponds to an indication that a product should be replenished. Kenny's distinctive display of items on a shopper's reorder list (i.e., "hot spots," see e.g., Figure 5; 6:34-44; 9:59-60; 12:50-54) cannot correspond to an indication that a product should be replenished because Kenny's distinctive display of reorder items is not limited to those that should be reordered. Rather, Kenny distinctively displays all items on the shopper's reorder list. Although Kenny's reorder list "shows items to be reordered as of the current date" (11:28-34), it does not include a control that is useable by the shopper to reorder the product. As such, Kenny describes nothing that corresponds to the recited indication.

B. Kenny Does Not Teach or Suggest Providing a Consumer with an Indication that a Product Should Be Replenished, the Indication Including a Control Usable by the Consumer to Request Replenishment of the Product by Performing a Single Action

On pages 7-8 of the Examiner's Answer, the Examiner states:

Kenny discloses that a shopper can select a product to be ordered by clicking on the product while it is displayed on the computer screen (col. 12 line 55+). The examiner interprets this as performing a single action and the location on the screen for displaying product to be a defined region for making requests (see Figs. 5-9).

Appellants respectfully disagree. Contrary to the Examiner's position, Kenny does not teach or suggest a control to request replenishment of the product by performing a single action. Indeed, in the Office Action mailed on December 29, 2005, the Examiner acknowledged that "Kenny does not teach the step of requesting replenishment of the product by performing a single action." (Office Action, December 29, 2005, p. 4.) Although Kenny describes that products on a shopper's reorder list may be displayed in a way that is visually distinct relative to the other products, i.e., using "hot spots" to identify goods on the shopper's reorder list (6:34-44; 9:59-60; 12:50-54), nowhere does Kenny suggest that a hot spot is a control for requesting replenishment of a product by performing a single action. In fact, Kenny explains that "products can be selected for purchase...by clicking on the product or hot spot in a distinctive manner"

and "Once a list has been created for the products to be purchased, the products can be ordered." (7:5-13; 9:59-60; 10:64-67; emphasis added.)

Appellants are perplexed as to how the Examiner arrives at the conclusion that a hot spot is the same as a control useable by a consumer to request replenishment of a product by performing a single action. Actuation of a hot spot simply selects the product for purchase by placing it in the shopping cart of the shopper. Because the shopper must perform additional steps to purchase the product (7:25-33), Kenny clearly contains no indication of the recited control. Moreover, the Examiner has not provided any reason to modify Kenny's technique such that a product on a shopper's reorder list is ordered solely in response to the shopper clicking on the product's hot spot.²

C. Kenny Does Not Teach or Suggest Placing an Order on the Consumer's behalf for Replenishment of the Item within a Predetermined Tolerance of the Target Date

On page 8 of the Examiner's Answer, the Examiner states:

Kenny also discloses that a product reorder list is made by considering order frequency and average time between product purchases (col. 11 line 21+) and that the reorder list can be automatically generated (col. 11 line 30). The examiner interprets this as determining a target date and placing orders on the consumer's behalf within the target date.

Appellants respectfully disagree. The Examiner's position is unsupported. Although Kenny describes that a shopper can create a reorder list (11:13-34) that can be automatically generated and made available at the beginning of a shopping session (4:20-24), nowhere does Kenny teach or suggest using the reorder list to place orders on the shopper's behalf, as suggested by the Examiner. The only explanation for the Examiner's interpretation is that it is based on impermissible hindsight.

² The Examiner does not contend that either Ono or Hirst discloses the recited feature. Indeed, Ono fails to teach or suggest an indication that includes a control usable by the consumer to request replenishment of the product by performing a single action because Ono requires the user to select products for purchase and then confirm the order using an OK button. (7:25-33 and 8:8-17.) Hirst also fails to teach or suggest a control usable by the consumer to request replenishment of the product by performing a single action because Hirst contains no indication of any control for requesting replenishment of printer toner, much less a control usable by the consumer by performing a single action. (5:1-40.)

D. Nowhere Does Ono Teach or Suggest Transmitting Information of a Product Whose Purchase Interval has Lapsed On or Before the Target Date Or Determining a Target Date for Suggesting Replenishment of an Product

On page 8 of the Examiner's Answer, the Examiner states:

Ono discloses determining whether a product purchase interval has lapsed after the latest purchase day (103, Fig. 1) and transmitting information of a good whose purchase interval has lapsed to a service offering system and displaying the information at the service use [sic] system (abstract, 104, 223, Figure 1). The examiner interprets this as providing information regarding a good whose purchase interval has lapsed and determining a target date for suggesting replenishment of an item.

Appellants respectfully disagree. Although Ono describes providing information regarding a product whose purchase interval has lapsed, Ono contains no indication of providing this information on or before the target date. Rather, Ono describes a technique that, only in response to receiving user identification information, provides the user with information of the products whose purchase intervals have lapsed. Because Ono only judges whether a purchase interval has lapsed when a user provides his or her identification information, Ono fails to teach or suggest transmitting information of a good whose purchase interval has lapsed on or before the target date or determining a target date for suggesting replenishment of an item.

E. Nowhere Does Hirst Teach or Suggest Scheduling for a Time Preceding the Expiration Time a Unilateral Transmission of a Communication to the Purchasing Entity Indicating that the Item Should be Replenished

On page 8 of the Examiner's Answer, the Examiner states:

Hirst discloses providing a signal to controls and displays to indicate a warning message reminder (128, 130, Fig. 6) to schedule a reordering process for a particular product. The examiner interprets this as scheduling for a time preceding the expiration time a unilateral transmission to the purchasing entity that the item should be purchased.

Appellants respectfully disagree. Hirst describes monitoring the consumption of a printing supply, such as toner, in a printer. (5:1-40.) Although Hirst describes providing a warning message to indicate a low toner condition, Hirst contains no indication of scheduling the warning message at a time preceding a determined

expiration time of the printing supply. Rather, Hirst provides a warning only when the consumption of toner surpasses a specified limit.

F. The Examiner Has Failed to Identify a Sufficient Reason for Combining Kenny, Ono, and Hirst

The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 U.S.P.Q. 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

The recent Supreme Court decision in *KSR Int'l v. Teleflex, Inc.*, No. 04-135 (U.S. Apr. 30, 2007) reaffirmed the holdings of Graham, and clarified several aspects of the manner in which obviousness should be determined. KSR, p. 11. In particular, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art," rather, "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." KSR, p. 14-15. The Court recognizes that many significant advances will combine familiar elements: "inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." KSR, p. 15.

Following the decision in KSR, the USPTO issued a memorandum to all Examiners. The memorandum directs Examiners to continue to determine why a person of ordinary skill in the art would make the combination, "in formulating a rejection under 35 U.S.C. 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." "Supreme Court decision on *KSR Int'l v. Teleflex, Inc.*," May 3, 2007, p. 2.

Under these standards, Appellants' invention would not have been obvious because the Examiner has not identified prior art references, or a combination thereof, that disclose all the elements of the pending claims. Moreover, the Examiner has failed to identify a sufficient reason for combining the cited prior art references.

To present a *prima facie* case of obviousness, the Examiner must show that "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 14 (U.S. Apr. 30, 2007). The Examiner's analysis "should be made explicit. *Id.* [R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* (citing *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006)).

On page 5 of the Examiner's Answer, the Examiner states the following as the reason to combine Kenny and Ono:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Kenny to transmit information of the good whose purchase interval has lapsed or to provide an indication to the consumer on or before the target date, as taught by Ono, so the consumer will not run out of the item because it would estimate a demand occurrence time for each good and supply a user with the merchandise information at the estimated time of the next purchase. (Emphasis added.)

Appellants respectfully disagree. As discussed above in Section II.D, Ono fails to teach or suggest transmitting information of a good whose purchase interval has lapsed on or before the target date or determining a target date for suggesting replenishment of an item. Indeed, Ono requires that the user start an online shopping session before Ono judges whether the purchase interval has lapsed for any product identified in the user's purchase history. (Ono, 4:28-57; Kenny, 6:41-43, 11:20-34.) Thus, Ono does not transmit information of a product having a lapsed purchase interval so that the consumer does not run out of the product, as suggested by the Examiner. Rather, consistent with Ono's stated purpose of reducing the number of products the user forgets to purchase (4:56-57), Ono identifies products whose purchase interval has lapsed only during a shopping session. Moreover, the reason provided by the Examiner appears to be based solely on the alleged beneficial results that would be produced by

combing the references, without identifying any reason other than the Examiner's conclusory statements that supports the combination.

On page 7 of the Examiner's Answer, the Examiner states the following as the reason to combine Kenny, Ono, and Hirst:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the message indication and the automated reordering, as taught by Hirst, in the combined system of Kenny in view of Ono because it would ensure that customers are aware of an upcoming event and that products are ordered in a timely fashion.

Appellants respectfully disagree. As discussed above in Section II.E, Hirst fails to teach or suggest scheduling the warning message at a time preceding a determined expiration time of the printing supply. Moreover, there would be no reason to combine Hirst with either Kenny or Ono. Hirst monitors a printer's toner consumption and reports a low toner condition only when the consumption of toner surpasses a specified limit. Because neither Kenny nor Ono monitor the consumption of products purchased by a shopper, Hirst's reporting technique would serve no practical purpose.

IV. Conclusion

For at least these reasons, along with the reasons presented in Appellants' Appeal Brief, each of claims 1-37 and 39-47 has been improperly rejected. Accordingly, Appellants seek reversal of the rejection of these claims.

The Commissioner is hereby authorized to charge any shortages or credit any overpayment associated with this filing to our Deposit Account No. 50-0665, under Order No. 249768020US1 from which the undersigned is authorized to draw.

Date: 12/10/07

Respectfully submitted,

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